

REMARKS

Applicants appreciate the careful consideration given by the Examiner in the Office Action dated July 9, 2007. In the Action, claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Application 2003-345114 A, submitted by Tsuda (hereinafter "Tsuda") in view of Japanese Patent Application 08-339115, submitted by Iguchi (hereinafter "Iguchi").

35 U.S.C. §103(a)

Applicants respectfully traverse all of the rejections under §103(a). Applicants would initially point out that the rejections are not properly formed. MPEP §707.02 states that, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." In the Office Action under consideration, the Examiner simply writes that paragraphs 22-23 and Drawing 1 of the machine translation of Tsuda teach *each and every* feature of claim 1 with the exception of the placement of the discharge hole. The Examiner fails to point out how particular parts of the illustrated device in Tsuda disclose or read on the particulars of claim 1 of the present invention. That is to say, the Examiner does not point to particular reference numerals nor offer any explanation to establish that the device disclosed in Tsuda is, with the exception of the discharge hole, the same as the developer container of the present application. Applicants are left to interpret the reference without guidance. As discussed below, Applicants assert that the best interpretation of Tsuda simply does not disclose the novel features of claim 1. Therefore, the Office fails to make a *prima facie* case of obviousness.

Turning specifically to claim 1, the Action states that paragraph 23 of the machine translation of Tsuda teaches:

conveying means in an inner circumferential portion of the container main body, for conveying the developer in the axial direction when the container main body is rotated about the axis, the conveying means having a plurality of conveying portions extending in an extending direction from one end portion to the other end portion in the axial direction as it is directed to a downstream side in a rotation direction,

Cited paragraph 23 of Tsuda first discloses that the 1st height 5 and 2nd height 6 are provided “in one in blow molding to the toner bottle body 2,” as shown in Drawing 1. The paragraph goes on to describe that the direction of the spiral of the first height 5 is the direction of the rightward broken arrow in Drawing 1.

In Tsuda, the protruding piece or groove, designed to agitate and move the toner, spirals and crisscrosses itself in what appears to be a singular segment on the inside of the toner bottle. This is seen in both Drawing 1 and Drawing 3. It is difficult to ascertain with certainty whether there are a “plurality of conveying portions” with different heights or if the entire length of the conveying portion is a single connected portion of varying height at different segments. However, in order to expedite prosecution, Applicants have amended claim 1 to specify that each of the plurality of conveying portions is disconnected from the others. Applicants assert that Tsuda does not disclose such disconnected conveying portions as recited in amended claim 1.

A second key feature that is lacking in Tsuda is found in the next paragraph of claim 1, which recites,

“...the conveying portions being formed at intervals in a circumferential direction thereof and the axial direction, of which adjacent two conveying portions in the axial direction being arranged in such a manner that an end portion on a downstream side in the rotation direction of one conveying portion and an end portion on an upstream side in the rotation direction of the other conveying portion adjoin each other in the axial direction.”

Tsuda does not disclose these features relating to the manner of arrangement of the conveying portion in intervals *anywhere* in Drawing 1 or in paragraphs 22-23. The reason for this is quite simple: in Drawing 1, there are no *adjacent conveying portions* from which to determine an arrangement, as the conveying portion in Drawing 1 is continuous. As seen in Applicants’

specification (beginning on page 12, line 5) these recited features result in a particular advantage. Due to the constitution of the developer container recited in amended claim 1, even when the container main body is given a twisting force from the outside about the axis, a bending force from the outside, and an impact, the occurrence of damage and deformation of the container main body can be prevented as much as possible. Further, coagulation of a developer can be prevented as much as possible.

Applicants have reviewed the entire Tsuda reference in order to determine the scope of the disclosure. Applicants would point out that claim 1 is additionally distinguishable over Drawing 5 in Tsuda, which illustrates an “intermittent” spiral in the toner moving groove or structure. See paragraph 46 of the machine translation. While this drawing might possibly be interpreted as depicting a conveying structure in intervals, the arrangement of said structure is dissimilar to that recited by claim 1. Specifically, in Drawing 5, the location of “a downstream side” is at the top of the figure, such that the end portion of one conveying portion on the downstream side in the rotation direction is adjacent to the downstream side in the rotation direction of the adjacent conveying portion. In contrast, claim 1 requires that downstream side of a conveying portion be adjacent to the upstream side of the adjacent conveying portion. Drawing 5 does not disclose the features of Applicants’ amended claim 1.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.*

Applicants assert that, as discussed above, the Action does not establish a *prima facie* case of obvious due to the missing features of Tsuda. Further, the secondary reference, Iguchi, fails to supply the missing features, as the spiral slot 13 in Iguchi is clearly continuous in two sections, wherein the termination points of the slot are on either side of the discharge hole. The toner conveying sections are thus not adjacent, nor are they in the *same location* stream-wise (no rotation direction is provided) as is recited by claim 1.

The Action cites Iguchi primarily to establish that a discharge hole in the middle of a toner bottle is known in the art. Applicants do not contest this fact, but do traverse the motivation for combining Tsuda with Iguchi. The Action states that it would have been obvious to combine the references in order to reduce the distance that the developer would have to be conveyed and to save container volume by reducing groove size. However, groove structure in Tsuda is designed in a particular manner and for particular reasons so as to convey toner to a discharge at one end of the cylinder. Specifically, Tsuda uses different heights in groove size as well as different groove patterns in order to successfully convey developer. MPEP §2301 points out that references should not be combined if the proposed modification renders the prior art unsatisfactory for its intended purpose or the proposed modification changes the principle of operation of a reference. The Action's attempt to modify Tsuda would impinge on a design feature of Tsuda which uses groove patterns of particular and different heights to convey toner. There is no evidence that moving the discharge hole in Tsuda to substantially the middle portion of the container body could be accomplished without upsetting the scheme for conveying toner as designed. The Action thus fails to establish a *prima facie* case of obviousness as it relates to the motivation to combine references as well.

Applicant asserts that claims 1 is allowable for at least the reasons discussed above. Additionally, claims 2-8 are also viewed as allowable for at least the reasons set forth above regarding corresponding independent claim 1, and/or for the further features claimed therein.

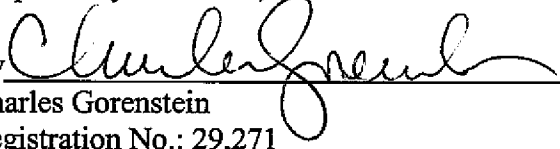
Conclusion

In view of the above amendment, Applicant believes the pending application is in condition for allowance, and solicits a notice thereof. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact James M. Alpert, Reg. No. 59,926 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 9, 2007

Respectfully submitted,

By 
Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant